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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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GOLDBERG EXAMINER

12M2/1025

ART UNIT	PAPER NUMBER
1205	3

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DATE MAILED: 10/25/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 6/6/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-12 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-12 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

Applicants elected the inventions drawn to methods for treating Lupus erythematosus with traversed in a telephone conversation with Mr. Thomas O. McGovern on September 28, 1995.

Claims 1-12 are drawn to compositions and method for treating various types of typical conditions including inflammatory conditions as well as psoriasis. Applicants are, therefore, required to elect a specific medical condition for examination in the merits and to add a claim to the specific condition.

Each invention above is independent from the other since, for example the mode of action for treating an inflammatory condition is completely different from treating psoriasis or urticaria. Moreover, literature search for the methods would be completely different as a reference for treating an inflammatory condition.

The search considerations are, therefore, not limited to patent file searching and would constitute a burden on the Examiner.

In view of this, the several inventions are independent and distinct and would support separate patents and a reference under 35 U.S.C. 103 to one invention would not be a reference to the other invention, i.e. psoriasis treating would not render obvious inflammatory conditions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper restriction for examination purposes as indicated is proper.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-12 are rejected under 35 U.S.C. § 103 as being unpatentable over the EP 184,162 patent of record. The patent clearly teaches applicants' compound for treating lupus erythematosus (see page 67, line 3) by external administration (see page 76, line 15). In view of this, one skilled in the art would be motivated to prepare topical pharmaceutical composition containing the prior art compounds for treating lupus erythematosus.

Claims 1-10 are rejected over the claims of U.S. Patent 5,366,971. These composition claims were examined with the elected invention in the parent patent 5,366,971. The presence of these claims in the instant application obviously raises the issues of double patenting.

Claims 1-4, 9, and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 9, and 10 are improperly drawn to the "use of" language correction is required.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine is (703) 308-4556 or 305-3592.

GOLDBERG:jd
OCTOBER 20, 1995

JEROME D. GOLDBERG
PRIMARY EXAMINER
GROUP 1200